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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/586,119	06/02/2000	Michael D. Hamerski	55420USA9A.002	6205

7590 01/22/2002

Attention David B Patchett  
Office of Intellectual Property Counsel  
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PO Box 33427  
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EXAMINER

CHANG, VICTOR S

ART UNIT

PAPER NUMBER

1771

DATE MAILED: 01/22/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

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**Office Action Summary**

Application No.

09/586,119

Applicant(s)

HAMERSKI, MICHAEL D.

Examiner

Victor S Chang

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 26-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

## DETAILED ACTION

### *Election/Restrictions*

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

- I. Claims 1-25, drawn to the adhesive tape with progressive adhesive properties, classified in class 428, subclass 343.
- II. Claims 26-34, drawn to the method of attaching and delaminating a structure to a substrate, classified in class 156, subclass 60+.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the method of attaching and delaminating a structure to a substrate as claimed can be employed to attach and delaminate materially different product, such as a adhesive film strip with bond area that decreases at one end (Luhmann, US 5626931).

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

During a telephone conversation with David Patchett on January 11, 2002 a provisional election was made with traverse to prosecute the invention of I, claims 1-25.

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Affirmation of this election must be made by applicant in replying to this Office action.

Claims 26-34 are withdrawn from further consideration by the examiner, 37 CFR

1.142(b), as being drawn to a non-elected invention.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being obvious over Bries et al. (US 6001471) in view of Luhmann (US 5626931).

The applied primary reference has a common assignee/inventor with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art only under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 103(a) might be overcome by: (1) a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not an invention "by another"; (2) a showing of a date of invention for the claimed subject matter of the application which corresponds to subject matter disclosed but not claimed in the reference, prior to the effective U.S. filing date of the reference under 37 CFR 1.131; or (3) an oath or declaration under 37 CFR 1.130 stating that the application and reference are currently owned by the same party and that the inventor named in the

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application is the prior inventor under 35 U.S.C. 104, together with a terminal disclaimer in accordance with 37 CFR 1.321(c). For applications filed on or after November 29, 1999, this rejection might also be overcome by showing that the subject matter of the reference and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person. See MPEP § 706.02(l)(1) and § 706.02(l)(2).

Bries' patent is directed to adhesive tapes with a controlled sequential release of adhesive surfaces, and the tape can be removed without substantially damaging the surface or leaving substantial adhesive residue (column 1, lines 13-18). Bries discloses an improvement to double-sided stretchable adhesive tapes for use in conventional applications, particularly including the mounting or joining of an object to another surface (column 2, lines 37-41). Moreover, Bries' invention is applicable to all stretchable tape constructions, including the use of plastic backing materials and/or elastic backing materials (column 2, lines 48-50). Bries teaches that its advantages may be attained by utilizing adhesive tapes having a lower-adhesion or non-adhesive portion of one adhesive surface (column 2, lines 59-62). A non-adhesive portion may be adhesive-free, or may be an adhesive layer portion, which is rendered non-adhesive. A lower-adhesion portion may comprise a low adhesion material, i.e., a weaker adhesive, or may be rendered lower in adhesion by a treatment or coating, or a release strip is preferably used to deaden the adhesive on the one side. Alternatives useable for release strips include films, papers, powders, foams, inks, other coatings or treatments, and the like (column 2, lines 66-67, and column 3, lines 1-15). Bries'

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invention also provided a tape with a pull tab for separation of the adhesively aggressive surface portions from the structures progressively from one end toward the other (column 3, lines 20-36). Suitable materials include any materials which are stretchable without rupture by at least 50 percent elongation at break and which have sufficient tensile strength so as not to rupture before debonding. Such stretchable materials may be either elastically deformable or plastically deformable provided sufficient stretching is possible to cause adhesive debonding of both adhesive surfaces for stretch removal (column 13, lines 46-54).

Bries shows all the features of the instant claimed invention except for the position of the first and second adhesion regions are in the opposite direction to the instant claimed invention (claim 1), the plurality of adhesive regions with progressively reduced adhesive properties and their surface areas (claims 6-10, 18-23), and the capability of delaminate from the substrate by reverse peel (claims 15, 17). It would have been obvious to one having ordinary skill in the art at the time the invention was made (for claims 1-12) to rearrange the position of the first and second adhesion regions to still be able to facilitate a controlled sequential release of adhesive surfaces, and the tape can be removed without substantially damaging the surface, since it has been held that rearranging parts of an invention involves only routine skill in the art. *In re Japiske, 86 USPQ 70.* As to the reducing adhesive properties, Luhmann's invention relates to adhesive strips with shaped ends, which disappears in the adhesive joint. Luhmann discloses that by terminating the adhesive strip end in a pointed, serrated, convex curved or wavy shape, the adhesive surface is rendered progressively less

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adhesive toward the end of the strip. Alternatively, the reduction can be obtained by means of a cover or print to progressively reduce the adhesive area (column 3, lines 26-30). Additionally, the Examiner takes Official notice that the process of 'reverse peel' is inherently the same as the regular 'removal tab', which typically comprises a tab adhered to the bottom surface of the attachment strip with a non-adhesive interface between the restraint and the surface to which the restraint is attached, so as to provide an easy removal process of the attachment.

As such, in the absence of unexpected results, it would have been obvious to one of ordinary skill in the art to make adhesive articles with progressive adhesive properties based on the removable adhesive tape with controlled sequential release as taught by Bries, and with reduced adhesive areas, as disclosed by Luhmann, motivated by the improved removal process of these tapes without damaging to the substrate surface, and by the expectation of success imparted by the teachings of the prior art.

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. In addition, the following references are cited of interest for making adhesive articles with progressive adhesive properties:

US 5468231 to Newman et al.

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8 - 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone numbers

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for the organization where this application or proceeding is assigned are 703-305-0771

for regular communications and 703-305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

VSC

January 14, 2002

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1900  
1700

*Daniel Zinker*